

## REMARKS

Reconsideration and allowance of the subject application are respectfully solicited in view of the foregoing amendments and the following remarks.

Claims 12 through 14, 16, and 27-37 are pending, with Claims 12, 27, 30, 32, and 35 being independent. Claims 15 and 17 through 26 have been cancelled without prejudice. Claims 12 and 16 have been amended. Claims 27 through 37 have been added.

Claims 12 through 26 are variously rejected under the judicially-created doctrine of non-statutory obviousness-type double patenting over Claims 4, 7 through 12, and 19 through 27 of U.S. Patent No. 6,0149,169 (Azusawa, et al.), taken alone or in combination with U.S. Patent No. 5,561,498 (Sekine, et al.).

In response, Applicants submit that as amended, the application is allowable because Claims 15 and 17-26 have been canceled without prejudice, thereby rendering the rejection of these claims moot, and because amended independent Claim 12 is allowable for the following reasons.

Claim 12 has been amended to recite control means for controlling the driving means to permit a correcting operation of the correcting means in the case that the image pickup means is outputting the electrical image signal and to inhibit a correcting operation of the correcting means in the case that the image pickup means is not outputting the electrical image signal.

MPEP § 802 II(B)(i) states that “[a] double patenting rejection of the obviousness-type. . . is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection

is not considered prior art”. And satisfying the obviousness requirements of § 103 means that the cited art must disclose or suggest *all* the claimed features, in accordance with MPEP § 2143. Therefore, to reject Claim 12 for obviousness over Claims 4, 7 through 12, and 19 through 27 of U.S. Patent No. 6,0149,169 (Azusawa, et al.), the claims of this patent must recite control means for controlling driving means to permit a correcting operation of correcting means in the case that an image pickup means is outputting an electrical image signal and to inhibit a correcting operation of the correcting means in the case that the image pickup means is not outputting the electrical image signal, as recited by amended Claim 12. But, the Office has not alleged that these features are recited in Claims 4, 7 through 12, and 19 through 27 of the Azusawa, et al. patent. Until the Office addresses this issue, the Office has not yet established a prima facie case of obviousness against amended Claim 12. In addition, solely to expedite prosecution, Applicants will shortly file a Terminal Disclaimer, removing the patent to Azusawa, et al. as a reference.

Independent Claims 27, 30, 32, and 35 recite additional features of the invention and are believed to be patentable over the cited art.

Claim 27 recites, in part, control means for controlling the driving means to permit a correcting operation of the correcting means in the case that the image pickup means is outputting the electrical image signal and the recording means is recording the electrical image signal output from the image pickup means, to permit a correcting operation of the correcting means in the case that the image pickup means is outputting the electrical image signal and the recording means is not recording the electrical image signal, and to inhibit the correcting operation of the correcting means in the case that the image

pickup means is not outputting the electrical image signal or the reproducing means is reproducing the electrical image signal recorded by the recording means.

Claim 30 recites, in part, control means for controlling the driving means and the correcting means to hold an optically correcting position of the correcting means in the case that the optically correcting operation of the correcting means is stopped during a recording operation of the recording means.

Claim 32 recites, in part, control means for controlling the driving means and the correcting means to hold the optically correcting position of the correcting means in the case that the optically correcting operation of the correcting means is stopped during a recording operation of the recording means.

Claim 35 recites, in part, control unit which controls the driving unit to permit a correcting operation of the correcting unit in the case that the image sensing unit is outputting the image signal, and to inhibit a correcting operation of the correcting unit in the case that the recording/reproduction unit is reproducing the recorded image signal.

In view of the above amendments and remark, the application is in allowable form. Therefore, early passage to issue is respectfully solicited.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

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